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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/935,635  | 08/24/2001  | Jeffrey Green        | NA11P091/01.049.01  | 1384             |
| 28875   | 7590        | 06/16/2005           | EXAMINER            |                  |
| Zilka-Kotab, PC<br>P.O. BOX 721120<br>SAN JOSE, CA 95172-1120 |             |                      | HERNANDEZ, OLGA     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2144                |                  |
| DATE MAILED: 06/16/2005                                       |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/935,635

Applicant(s)

GREEN ET AL.

Examiner

Olga Hernandez

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 53105:20105.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 11-34, 36-43 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 12-30, 32-40 of U.S. Patent Application No. 09/935634. Although the conflicting claims are not identical, they are not patentably distinct from each other because

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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('635) discloses receiving an electronic file intended for delivery from a sender to an intended recipient; determining whether the electronic file represents a potential security risk to a computer system; if it is determined that the electronic file represents the potential security risk, then forwarding to the intended recipient a notification indicating that the electronic file represents a potential security risk; and receiving from the intended recipient a request to view the content of the electronic file; converting the electronic file from a first file format to a second file format that is different from the first file format and that prevents a computer virus in the electronic file from executing when the converted electronic file is opened by the intended recipient, the converting of the electronic file being in response to a determination that the electronic file represents the potential security risk to the computer system. While, ('634) discloses receiving a certain electronic file intended for delivery from a sender to an intended recipient, the certain electronic file having a first file format having a first file extension and containing a computer virus; and prior to certain electronic file being made available for viewing by the intended recipient, converting the certain electronic file to a second file format having a second file extension that is different from the first file extension of the first file format and that prevents the computer virus from executing when the converted electronic file is opened by the intended recipient; wherein it is determined whether the certain electronic file represents at least a potential risk to security of a computer system, the converting the certain electronic file being in response to a determination that the certain electronic file represents at least potential risk to the security if the computer system. The difference between these two independent claims is that ('634)

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includes the first and second files formats having (each one) a file extension of the respective format. However, ('635) discloses the second format being at least one of a TXT format, a RTF file format without embedded objects, a BMP file format, a JPEG file format, a CSV file format, a JPB file format, a GIF file format, a HTML file format without scripts and a ASCII file format. Most of these formats include an extension. Moreover, ('634) discloses the electronic file being at least one of a word processing file, a spreadsheet file, a database file, a graphic file, a presentation file, a compressed file and a binary executable file, which is the same as the formats described above (e.g. TXT). The applicant is simply using similar language, which has the same meaning considered to be functional equivalent by one skilled in the art. Note that a TXT format is equivalent to a word processing file format. A common word processing file is MS WORD, which is common knowledge that uses an extension to differentiate the file from other files to be used in another applications/software/programs. Using similar and/or different language to no further limit the invention does not provide different subject matter to be defined by the metes and bounds of the claims.

Further, both applications disclose the computer being at least one of a desktop computer of the intended recipient; a server, and a gateway connected to a network (e.g. internet).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-9, 11-21, 23-34, 36-37, 39-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Maloney et al (6,549,208).

As per claims 1, 6, 8, 11, 31, 33, 36 and 40, Maloney discloses receiving an electronic file intended for delivery from a sender to an intended recipient; determining whether the electronic file represents a potential security risk to a computer system; if it is determined that the electronic file represents the potential security risk, then forwarding to the intended recipient a notification indicating that the electronic file represents a potential security risk; and receiving from the intended recipient a request to view the content of the electronic file; converting the electronic file from a first file format to a second file format that is different from the first file format and that prevents a computer virus in the electronic file from executing when the converted electronic file is opened by the intended recipient, the converting of the electronic file being in response to a determination that the electronic file represents the potential security risk to the computer system (column 2, lines 2-3, 30-54, column 4, lines 39-42, column 6, lines 33, 66-67, column 7, lines 1-4, column 9, lines 27-53).

As per claims 2 and 32, Maloney discloses converting occurring in response to the receiving the request to view the contents of the electronic file (column 9, lines 27-44).

As per claim 3, Maloney discloses converting occurring prior to the receiving the request to view the contents of the electronic file (column 9, lines 27-44).

As per claims 4 and 7, Maloney discloses receiving an electronic file intended for delivery from a sender to an intended recipient; converting the electronic file from a first file format to a second file format file that is different from the first file format and that ensures that a computer virus in the electronic file is unable to harm a computer of the intended recipient, the converting of the electronic file being in response to a determination that the electronic file represents a potential security risk to the computer; and forwarding a uniform resource locator to the intended recipient of the electronic file, the uniform resource locator identifying at least an address of a web page containing the converted electronic file (column 1, lines 60-67, column 2, lines 2-3, 15-19, column 4, lines 60-67, column 5, lines 1-3, column 6, lines 33, 66-67, column 7, lines 1-4).

As per claims 5, 24 and 27, Maloney discloses the second format being a HTML file format without scripts (column 10, lines 24-25).

As per claim 9, Maloney discloses saving the converted file in memory accessible to the intended recipient (column 1, lines 20-38, column 11, lines 4-8).

As per claim 12, Maloney discloses conducting a heuristic scan of the certain file (column 9, lines 39-44).

As per claims 13 and 34, Maloney discloses the electronic file being an attachment to an electronic mail sent over a network (column 2, lines 50-54).

As per claim 14, Maloney discloses the Internet (column 1, lines 14-16).

As per claims 15 and 41, Maloney discloses receiving occurring at a desktop computer of the intended recipient (column 5, lines 59-61).

As per claims 16 and 42, Maloney discloses receiving occurring at a server computer (column 4, line 36, figure 6).

As per claims 17 and 43, Maloney discloses receiving occurring at a gateway computer (column 11, line 55, figure 6).

As per claim 21, Maloney discloses receiving a second file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus; converting the second electronic file to a fourth format that is different from the third format and that prevents that another computer virus from executing when the converted second electronic file is opened by the another intended recipient; and making the converted second electronic file available for viewing by the another intended recipient (column 11, lines 36-41, column 12, lines 16-24).

As per claims 18-20, Maloney discloses the collection of multiple interconnected computer of intended recipient (column 2, lines 24-25, column 5, line 60, column 7, lines 30-33, figure 3).

As per claims 23, 29, 37 and 39, Maloney discloses the second file format being at least one of TXT file format, RTF file format without embedded objects, a BMP file format, a JPEG file format, a CSV file format, a JPB file format, a GIF file format, a HTML file format without scripts, and an ASCII file format (column 10, lines 24-25).



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As per claims 25, Maloney discloses the second file format being the ASCII file format file (column 1, lines 10-11).

As per claims 26, Maloney discloses the second file format being the TXT file format (column 6, lines 52-53).

As per claims 28, 29 and 37, Maloney discloses the certain electronic file being at least one of a word processing, spreadsheet, database, graphics, presentation, compressed and binary executable files (column 10, lines 24-25).

As per claim 30, Maloney discloses the electronic file being received by a HTTP transfer protocol (column 5, line 2).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al (6,549,208) in view of Chen (5,960,170).

Maloney does not explicitly suggest the computer virus including macro virus. However, Maloney determine if a computer virus is present and its generic structure (column 2, lines 50-54). Chen teaches macro viruses in emails (column 14, lines 54-57). Therefore, it would have been obvious to one skilled in the art to combine Chen's

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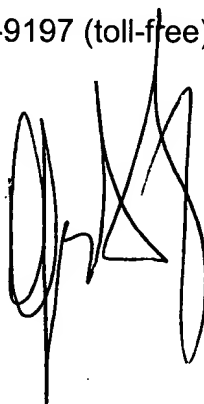
macro viruses with Maloney's email attachment assertion and identified them more clearly.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Hernandez whose telephone number is 571-272-7144. The examiner can normally be reached on Mon-Thu 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'OH' with a large loop and a vertical line extending downwards.

Olga Hernandez  
Examiner  
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